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10/733,125

12/11/2003

Robert Winegard

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DILWORTH & BARRESE, LLP  
333 EARLE OVINGTON BLVD.  
SUITE 702  
UNIONDALE, NY 11553

EXAMINER

CURS, NATHAN M

ART UNIT

PAPER NUMBER

2613

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/733,125

Applicant(s)

WINEGARD, ROBERT

Examiner

Nathan Curs

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 objected to because of the following informalities: the terms "port 2" and "port 3" should be "said second port" and "said third port", respectively. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5 recites that the claimed switch has an encryption device operable during secure mode operation. However, claim 5 depends from claim 2 (by way of claim 4), and claim 2 recites that the switch operates in secure mode when no power is supplied to the switch. Therefore, claim 5 is claiming that the switch has an encryption device operable when no power is supplied to the switch. The specification does not support the switch having an encryption device operable during a no power state. The specification only supports an operable encryption device during a switch's no power state where the encryption device is not part of the switch.

Regarding claims 9 and depending claim 10, claim 9 recites that no power is supplied to the switch during secure mode and claim 9 depends from claim 8 which claims a method "in a secure/non-secure bypass switch" where relays route signals through an encryption device. The specification does not support a method inside a switch having an encryption device where the encryption device is operable during a no power state of the switch.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Griffin (US Patent Application Publication No. 5666402).

Regarding claim 1, Griffin discloses a secure/non-secure bypass switch, comprising: a first port for receiving input signals (fig. 1, element LINE(1) and element 10 and col. 3, line 26 to col. 4, line 9); a first relay having an input, a first output and a second output (fig. 3C, element 84 and col. 7, lines 51-62), said input connected to said first port, and said second output connected to a second port (fig. 3C, element 84); a first fiber optic modem having an input and an output, said input connected to said first output of said first relay (fig. 1, element 10 and fig. 2, element 46 and col. 5, line 45 to col. 6, line 4); a second fiber optic modem having an input and an output, said input connected to said output of said first fiber optic modem (fig. 1, element 14 and col. 5, line 45 to col. 6, line 4); and a second relay having an output, a first input and a second input, said first input connected to said output of said second fiber optic modem, said

Art Unit: 2613

second input connected to a third port, and said output connected to a fourth port (fig. 3C, element 84, as applicable to the remote terminal).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US Patent Application Publication No. 5666402).

Regarding claim 2, Griffin discloses the switch of claim 1, and discloses the switch operates in a non-secure mode when power is supplied to the switch (col. 3, lines 26-50). Griffin discloses that the switch needs power for the modems to operate (col. 9, line 66 to col. 9, line 30), but does not disclose details of the operation of the switch when no power is supplied to the switch. However, since the switch depends on a power supply for powered operation, it also has an inherent power-off state. It would have been obvious to one of ordinary skill in the art at the time of the invention that the power-off state of the switch would be a secure operating state, since no data tampering or any other breach of information in the switch is possible when the switch is not powered on.

Regarding claim 3, Griffin discloses the switch of claim 2, wherein if the switch is operating in a non-secure mode, the input of the first relay is connected to the first output of the first relay, and the first input of the second relay is connected to the output of the second relay (fig. 3C, element 84 and col. 7, line 51 to col. 8, line 31).

Regarding claim 6, Griffin discloses the switch of claim 2, wherein power is supplied to the first and second fiber optic modems only during non-secure mode operation (col. 3, lines 26-50, where non-secure mode is disclosed, and col. 9, line 66 to col. 9, line 30, where power operation is disclosed).

Regarding claim 7, Griffin discloses the switch of claim 2, further comprising means for disconnecting power to the first and second fiber optic modems in the secure mode (col. 9, line 66 to col. 9, line 30, where the modems require power to operate and thus in a secure power-off state there is no power to the modems).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin (US Patent Application Publication No. 5666402) in view of Schmid et al. ("Schmid") (US Patent Application Publication No. 2005/0025302).

Regarding claim 8, Griffin discloses a method of secure/non-secure switching in a secure/non-secure bypass switch, comprising the steps of: receiving signals to be routed (fig. 1, element LINE(1) and element 10 and col. 3, line 26 to col. 4, line 9); in a non-secure mode, configuring relays to route the signals through at least two fiber optic modems to an output port (fig. 1, elements 10 and 14 and col. 3, lines 26-50). Griffin discloses that user devices can be standard telephone handsets or secure telephones (col. 3, lines 26-50), which reads on the step of determining if a secure or a non-secure operating mode is selected, but Griffin does not disclose any features of the secure telephones or that if a secure mode is selected, relays are configured to route the signals through an encryption device to said output port. Schmid discloses using secure telephone units, where "secure" means use of encryption (paragraphs 0004 and 0012). It would have been obvious to one of ordinary skill in the art at the time of the invention to use encryption-based telephone units for the secure telephone communications in

Art Unit: 2613

Griffin, to provide the advantage of telecommunications privacy and security between devices, as taught by Schmid.

***Allowable Subject Matter***

9. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent No. 6643783 – discloses a computer security system with secure and non-secure modes, using relays to select between secure and non-secure hard drives, where power is disconnected from secure drives in non-secure mode.
- US Patent Application Publication No. 6578089 – discloses using relays to switch computer system devices and peripherals between use with secure and non-secure computer systems.
- US Patent No. 6202153 – discloses secured and public networks with a server for accessing secured and public storage units.

11. Any inquiry concerning this communication from the examiner should be directed to N. Curs whose telephone number is (571) 272-3028. The examiner can normally be reached on M-F (from 9 AM to 5 PM).

Art Unit: 2613

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached at (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (800) 786-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JASON CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600